

### REMARKS

For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

### STATUS OF THE DRAWINGS

The drawing objections raised earlier have been withdrawn in view of the recent response from the Applicant.

### STATUS OF THE SPECIFICATION

No amendments have been made to the specification.

### STATUS OF THE CLAIMS

Claims 1, 3-11, and 13-30 remain in the case. Claims 1, 3-11, and 13-30 stand rejected. Claims 13 and 14 have been amended. No new claims have been added. No claims have been canceled.

### RESPONSE TO CLAIM OBJECTIONS

The recent Office Action mailed July 20, 2005 objects to Claim 14 based on informalities suggesting that Claim 14 and Claim 13 are duplicates. Applicants submit that Claims 13 and 14 are not duplicates but instead include subtle but important differences relating to the first and second receivers recited in Claim 9. Claim 13 as amended recites: "wherein the first storage device carrier is mounted on one side of the mounting surface by way of the first receiver, and the second storage device carrier is mounted to an **opposite side** of the mounting surface by way of the second receiver." Claim 13 refers to first and second storage device carriers that extend from opposite sides of the same mounting surface. In contrast, Claim 14 as amended recites "wherein the first storage device carrier is mounted on one side of the mounting surface by way of the first receiver, and the second storage device carrier is mounted on the **same side** of the mounting surface by way of the second receiver." Hence, Claim 14 refers to first and second storage device carriers that extend from one side, the same side of the mounting surface.

Applicants submit that while Claims 13 and 14 are very similar they recite fundamentally different concepts. Therefore, Applicants request that the objection of Claims 13 and 14 be withdrawn.

#### CLAIM AMENDMENTS

While claim amendments are not a matter of right after a final rejection, Applicants request that the claim amendments set forth above for Claim 13 and 14 be permitted in order to clarify a mounting means between the first and second storage device carriers and the single mounting surface. Specifically, the first storage device carrier mounts to the mounting surface by way of a first receiver and the second storage device carrier mounts by way of the second receiver. Support for these amendments is found in amended paragraph 29 and amended Figure 1 of the written description.

#### RESPONSE TO CLAIM REJECTIONS UNDER 35 U.S.C. § 102(b)

Claims 1, 3-6, 8, 9, 11, 13, 14, 16, 21, 24, 25 and 27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,445,587 to Pavol (hereinafter "Pavol"). Applicants respectfully traverse this rejection.

It is well settled that under 35 U.S.C. §102 "an invention is anticipated if . . . all the claim limitations [are] shown in a single art prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim. The identical invention must be shown in as complete detail as is contained in the patent claim." *Richardson v. Suzuki Motor Co., Ltd.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully assert that Pavol does not teach or suggest all of the elements of the rejected claims in view of the following remarks.

With regard to independent Claim 1, Applicants respectfully submit that Claim 1 is patentable over the cited reference. Claim 1 states:

An enclosure for storing at least one storage device, comprising:  
an enclosure chassis;  
a mounting surface oriented vertically and coupled to the enclosure chassis to form one wall of a drive bay, the mounting surface configured to receive a horizontally oriented storage device carrier, and the mounting surface having a first layer and a second layer;

a viscoelastic layer disposed between the first layer and the second layer to reduce vibration propagation throughout the mounting surface; and a receiver secured to the mounting surface and configured to retain a first storage device carrier substantially perpendicular to the mounting surface.

(emphasis added).

Applicants respectfully submit that Claim 1 clearly recites features not taught or suggested in Pavol. Pavol, in general, is directed toward a resilient layer and cover disposed between a drive tray housing and a drive module. Pavol, Abstract. Figure 2 and the accompanying description in col. 3, line 21 – col. 3, line 35 describe the resilient layer in relation to the drive module. Various positions for the resilient layer are then also described in relation to Figures 3-6.

In Applicant's response mailed May 18<sup>th</sup> 2005, Applicants established that Pavol fails to disclose "a receiver secured to the mounting surface and configured to retain a first storage device carrier," as recited in Claim 1. This element was originally in Claim 2.

The structures in Pavol closest resembling the vertical mounting surfaces are the bay sidewalls 136. Pavol Figure 3, col. 5, lines 4-15. However, these bay sidewalls 136 do not include any receivers. Applicants explained that a receiver is a specific mechanical structure that is secured to the vertical mounting surface.

In the recent Office Action mailed July 20, 2005, the Examiner interprets "receiver" as "something that receives." Applicants agree with this interpretation but submit that the Examiner has ignored the portion of the claim that recites that the "a receiver secured to the mounting surface" and that the receiver is "configured to retain a first storage device carrier substantially perpendicular to the mounting surface." Securing a receiver to a vertical mounting surface necessarily requires that the receiver be a separate and distinct component from the vertical mounting surface to which the receiver is secured.

The Examiner suggests that the surface of layer 126 that contacts and retains the drive carrier 106 in bay 108 anticipates a receiver as recited in Claim 1. See recent Office Action page 12. Applicants disagree. First, the Applicants suggest that the Examiner's response included a typographical error and meant to indicate the surface of layer 128, the cover layer, rather than

layer 126, which is the resilient layer. Layer 126 never contacts the drive carrier 106 in bay 108. Therefore, layer 126 can not serve as a receiver of drive carrier 106.

Second, if the cover layer 128 is considered the receiver by the Examiner, the cover layer 128 can not be secured to the mounting surface as that term is interpreted in Pavol. Instead, since the Examiner suggests that the cover layer 128 is a first layer and the bay side wall 136 is the second layer that together with the resilient layer 126 "anticipate" the vertically oriented mounting surface, the cover layer 128 can not be secured to the mounting surface as recited in Claim 1. To do so, contradicts logic and the claim language. The Examiner's interpretation would require that the cover layer 128 be secured to itself because the cover layer 128 is part of the mounting surface under the Examiner's interpretation. This interpretation is impossible and illogical.

The Examiner submits that Applicants have failed in recite a specific structure in reciting the receiver. Applicants disagree. The requirement in Claim 1 that the receiver be secured to the mounting surface indicates that the receiver is a separate specific structure. Therefore, Applicants have claimed a specific structure and have named that structure a "receiver."

The receiver may comprise a pair of rails formed from the vertical mounting surface or a different structure secured to the vertical mounting surface. As illustrated in amended Figure 1, the receiver may include a pair of parallel rails that engage the sides of the storage device carrier. See amended Figure 5. This engagement retains the storage device carrier perpendicular to the mounting surface, as recited in Claim 1. Following the Examiner's closest interpretation to its reasonable and logical conclusion, a cover 128 and bay side wall 136 that together are asserted as forming a mounting surface do not include a receiver. Even if the surface of the cover 128 is interpreted as a receiver, the surface of the cover 128 fails to retain the storage device carrier perpendicular to the cover 128 and bay side wall 136. Instead, the storage device carrier is retained in place by the top shelf 130 or bottom shelf 132. Absent the top shelf 130 and bottom shelf 132, the storage device carrier would not be retained by the surface of the cover 128. In fact, Pavol teaches that the cover 128 is smooth and slick to facilitate removal and installation of the storage device carrier. See Pavol Col. 5 line 60 – Col. 6 line 5. Applicants submit that because the prior art fails to teach a receiver secured to a vertically oriented mounting surface or

a receiver that retains a storage device carrier perpendicular to the mounting surface, Applicants are entitled to use the term receiver in Claim 1 and should not be restricted to a particular embodiment such as a pair of rails.

Pavol fails to teach or disclose any structure that retains a storage device carrier perpendicular to the mounting surface. Pavol discloses vertical drive modules which require more height for the drive bays than the horizontally oriented storage device carriers of the claimed invention. At most, Pavol discloses the interior of a vertical drive bay having no receiver structures for retaining the storage device carriers.

The recent Office Action asserts that the outer surface of the cover 128 within the bay 108 teaches "a mounting surface oriented vertically" as recited in Claim 1. The recent Office Action further asserts that the side walls of the bay 108 are oriented vertically. See Office Action mailed 7/20/05 page 2.

Applicants respectfully disagree with the Office Action's interpretation. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131.01, *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicants submit that the Office Action has impermissibly twisted and divided the elements of Claim 1 in order to suggest anticipation by Pavol. In doing so, the Office Action has ignored relevant features and aspects of elements recited in Claim 1.

Specifically, Claim 1 recites "a mounting surface ...configured to receive a horizontally oriented storage device carrier." Clearly, this phrase indicates that the storage device carrier is **oriented horizontally**. The adjectives "oriented" and "horizontally" in this clause modify the storage device carrier as a whole. However, the Office Action recites two different parts, the top and bottom, of a storage device carrier and submits that the top and bottom are oriented with the horizon. The Office Action interpretation is improper.

Applicants submit that such an interpretation is unreasonable and impossible in view of the language used in Claim 1. Claim 1 clearly recites that **the storage device carrier** is oriented horizontally, not portions of a storage device carrier as suggested in the Office Action. Applicants submit that the Office Action has twisted the claim language to reach an improper

interpretation. Pavol fails to teach a storage device carrier oriented horizontally. Therefore, the Office Action fails to make a *prima facie* case of anticipation because Pavol fails to describe each element as that element is set forth in the claim.

Claim 1 also recites that the mounting surface comprises "a first layer and second layer." The Office Action asserts that the cover 128 constitutes a first layer and the top shelf 130 or bottom shelf 132 of Pavol constitute the second layer. Applicants disagree because if the Office Action assertion were true, such an interpretation would contradict other elements of Claim 1.

In Claim 1, the viscoelastic layer is "disposed between the first layer and second layer." If the first layer is the cover 128 and the second layer is either the top shelf 130 or bottom shelf 132, the combination of the cover 128 and top shelf 130 or cover 128 and bottom shelf 132 which the Office Action asserts comprise the mounting surface must be horizontally oriented because the top shelf 130 and bottom shelf 132 are always horizontal in Pavol. See Pavol Figures 3-6. This contradicts the portion of Claim 1 that requires that the mounting surface be oriented vertically. Therefore, the interpretation suggested by the Office Action is unworkable and untenable.

Given that Pavol fails to teach or suggest all of the elements recited in Claim 1 of the present application, Applicants respectfully submit that independent Claim 1 is patentable over Pavol. Applicants also request that the rejection of Claim 1 under 35 U.S.C. § 102(b) be withdrawn. Given that dependent Claims 2-6, and 8 depend from Claim 1, Applicants respectfully submit that Claims 2-6, and 8 are also patentable over Pavol and request that the rejection of dependent Claims 2-6 under 35 U.S.C. § 102(b) also be withdrawn.

With regard to the rejection of independent Claim 9, Applicants respectfully submit that Claim 9 is patentable over the cited reference. Claim 9 recites two receivers. Applicants submit that the arguments above in support of one receiver lacking in the cited reference naturally and more strongly apply to the lack of two receivers in Pavol. The recent Office Action fails to specifically address the limitation of two receivers rather than just one. Applicants submit that this oversight is improper and denies the Applicants of a thorough examination in exchange for the required fee. Applicants request that the recitation of a first and second receiver be considered. Applicants further submit that the amendments to Claims 13 and 14 further highlight

the relevance of the limitation of a first and second receiver as recited in Claim 9. Applicants submit that since Pavol fails to teach one receiver, Pavol also fails to teach two receivers.

Given that the Office Action fails to show how Pavol teaches or suggests all of the elements recited in amended Claim 9 of the present application, Applicants respectfully submit that amended independent Claim 9 is patentable over Pavol. Given that dependent Claims 10-14 and 16 depend from Claim 9, Applicants respectfully submit that Claims 10-14 and 16 are also patentable over Pavol and request that the rejection of dependent Claims 10-14 and 16 under 35 U.S.C. § 102(b) also be withdrawn.

With regard to the rejection of independent Claim 21, Claim 21 "provides an interface shelf oriented horizontally and coupled to the enclosure chassis such that the interface shelf isolates horizontal storage device bays above the interface shelf from storage device bays below the interface shelf." Applicants find no teaching of an interface shelf in Pavol. The interface shelf isolates drive bays above the shelf from drive bays below the shelf. Applicants submit that Pavol fails to teach or suggest all of the elements of amended independent Claim 21. Claim 24 also includes the interface shelf recited in Claim 21.

Given that dependent Claims 25 and 27 depend from Claim 24, Applicants respectfully submit that Claims 25 and 27 are also patentable over Pavol and request that the rejection of dependent Claims 25 and 27 under 35 U.S.C. § 102(b) also be withdrawn.

#### RESPONSE TO CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 7, 10, 15, 17, 19, 20, 22, 23, and 26 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of Pavol in view of one or more of U.S. Patent No. 5,858,509 to Polch (hereinafter "Polch"), U.S. Patent No. 6,209,842 to Anderson et al. (hereinafter "Anderson"), and U.S. Patent No. 6,775,142 to Bell et al. (hereinafter "Bell"). Applicants respectfully continue to assert that neither Pavol nor Polch nor Anderson teach or suggest all of the elements of the rejected claims in view of the Applicants' response mailed May 18<sup>th</sup> 2005.

Claims 18 and 28-30 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of Pavol in view of Bell. Applicants respectfully continue to assert that neither Pavol nor Bell teach

or suggest all of the elements of the rejected claims in view of the Applicants' response mailed May 18<sup>th</sup> 2005.

In the recent Office Action, the Examiner submits that the location of the key makes does not overcome the rejection. Applicants respectfully submit that the key location is irrelevant because Pavol and Bell fail to teach or suggest "a receiver secured to the mounting surface and configured to retain a first storage device carrier."

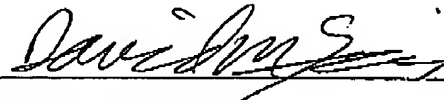
### CONCLUSION

As a result of the presented remarks, Applicant asserts that Claims 1, 3-11, and 13-30 are patentable and in condition for prompt allowance. Should additional information be required, the Examiner is respectfully asked to notify Applicant of such need. If any impediments to the prompt allowance of the claims can be resolved by a telephone conversation, the Examiner is respectfully requested to contact the undersigned.

Respectfully submitted,

Date: September 14, 2005

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